



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

AS

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/215,951 | 12/18/1998 | JOSEPH P. FELL | 659/489 | 1434 |

757 7590 10/21/2002

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60611

EXAMINER

CHEVALIER, ALICIA ANN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1772

26

DATE MAILED: 10/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|--------------------------------------|------------------------------------|--|
| Application No. 09/215,951 | Applicant(s) FELL ET AL. | |
| Examiner Alicia Chevalier | Art Unit 1772 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14-18 and 48-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14-18 and 48-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

WITHDRAWN REJECTIONS

1. The 35 U.S.C. §112 rejection of record in paper #23, page 3, paragraph #5 has been withdrawn.
2. The 35 U.S.C. §102 rejection of claims 48-50 as anticipated by Smith (5,209,801) of record in paper #23, pages 4-5, paragraph #7 has been withdrawn due to Applicant's amendment in paper #25.
3. The 35 U.S.C. §102 rejection of claims 48-50 as anticipated by Herrin (5,706,524) of record in paper #23, page 5, paragraph #8 has been withdrawn due to Applicant's amendment in paper #25.

REJECTIONS REPEATED

4. The 35 U.S.C. §102 rejection of claims 1, 3, 5-9, 15, 17, 18 and 48-50 as anticipated by Johnson (3,371,668) is repeated for reasons previously of record in paper #23, pages 3-4, paragraph #6.
5. The 35 U.S.C. §102/103 rejection of claims 1, 2, 4, 6-9, 15, 17 and 18 as anticipated by or over Smith (5,209,801) is repeated for reasons previously of record in paper #23, pages 6-7, paragraph #10.
6. The 35 U.S.C. §102/103 rejection of claims 1, 3 and 5-18 as anticipated by or over Herrin (5,706,524) is repeated for reasons previously of record in paper #23, pages 6-7, paragraph #10.

Art Unit: 1772

7. The 35 U.S.C. §103 rejections are repeated for reasons previously of record in paper #23, pages 8-12, paragraphs #12-15.

ANSWERS TO APPLICANT'S ARGUMENTS

8. Applicant's arguments filed in paper #25 regarding the present invention and the "improperly" construed claim limitation have been carefully considered but are deemed unpersuasive.

Applicant argues that the Examiner has improperly suggested that the recitation of "elongation of an elastic member" refers to the maximum elongation of the elastic member while the composite is being stretched, rather than the claimed ratio of the elongation of the claimed ratio of the elongation of an elastic member with reference to the maximum elongation of the composite. Furthermore, Applicant points out that the elastic member includes a certain maximum elongation, the composite has a maximum elongation, and the present invention claims the ratio of the maximum composite elongation to the maximum elongation of the elastic member.

While the Examiner finds this position to be somewhat persuasive it is not commensurate in scope with the claims for two reasons: (1) the claim language does not require "maximum" elongation of the elastic member and (2) support for this limitation was not found in the specification. The limitation on which Applicant relies "of at least about 85% of the [maximum] elongation of the elastic member" is not stated in the claims. It is the claims that define the claims invention, and it is the claims, not the specification that are anticipated or unpatentable. The current claim language does not specify the amount of elongation to be compared to the

Art Unit: 1772

maximum elongation of the composite material. Therefore, the Examiner's position that the "elongation of an elastic member" refers to the maximum elongation of the elastic member while the composite is being stretched reads on the claim language. Additionally, the Examiner cannot find support in the specification that the ratio is of the maximum composite elongation to the maximum elongation of the elastic member. However, the Examiner did find support for the ratio to be the maximum composite elongation to the initial elongation of the elastic member (page 7, lines 4-6). Applicant's later argument regarding their initial elongation of the elastic member to percent composite elongation is also found to be somewhat persuasive. Although, to make the claims commensurate in scope, Applicant would have to claim their initial elongation of the elastic member.

9. Applicant's arguments filed in paper #25 regarding the 35 U.S.C. §112 rejection of record have been considered but are moot since the rejections have been withdrawn.

10. Applicant's arguments filed in paper #25 regarding 35 U.S.C. §102 rejection of Johnson (3,371,668) have been carefully considered but are deemed unpersuasive.

Applicant's arguments regarding the limitation "at least about 85%" have already been addressed above.

Applicant argues that the composite fabric of the claims can achieve 100% composite elongation with an elastic elongation of 118% or less and that Johnson teaches a composite fabric capable of 100% maximum elongation requires elastic strands having an elongation of "a little better than" 200%, rather than 118% or less, as taught by the instant invention. This argument is found unpersuasive because the claims do not claim or have any requirement for the initial elongation value of the elastic members. Using Applicant's method of calculating the

Art Unit: 1772

ratio of elongation from page 5 of the amendment/response of record in paper #25, the initial elongation of the elastic members is 15% and the composite elongation is 100% giving a ratio of 100/15, which is well over 600%.

11. Applicant's arguments filed in paper #25 regarding the 35 U.S.C. §102 rejections of Smith (5,209,801) and Herrin (5,706,524) of record have been considered but are moot since the rejections have been withdrawn.

12. Applicant's arguments filed in paper #25 regarding 35 U.S.C. §102/103 and §103 rejection of Johnson (3,371,668) have been carefully considered but are deemed unpersuasive.

Applicant's arguments regarding these rejections revolve around the interpretation of the limitation "at least about 85%" which has already been addressed above.

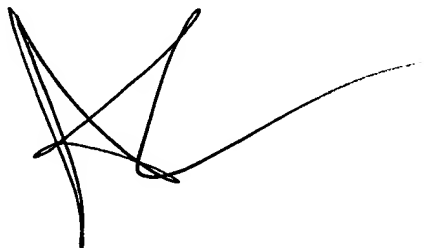
Conclusion


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia Chevalier whose telephone number is (703) 305-1139. The Examiner can normally be reached on Monday through Thursday from 8:00 a.m. to 5:00 p.m. The Examiner can also be reached on alternate Fridays

If attempts to reach the Examiner are unsuccessful, the Examiner's supervisor, Harold Pyon can be reached by dialing (703) 308-4251. The fax phone number for the organization official non-final papers is (703) 872-9310. The fax number for after final papers is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose phone number is (703) 308-0661.

ac
10/19/02




HAROLD PYON
SUPERVISORY PATENT EXAMINER
11/2 10/19/02